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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,818	03/31/2004	Niniane Wang	24207-10097	5059
62296	7590	12/31/2007		
GOOGLE / FENWICK SILICON VALLEY CENTER 801 CALIFORNIA ST. MOUNTAIN VIEW, CA 94041			EXAMINER HUNG, YUBIN	
			ART UNIT	PAPER NUMBER
			2624	
			MAIL DATE	DELIVERY MODE
			12/31/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/813,818	<b>Applicant(s)</b> WANG ET AL.	
	<b>Examiner</b> Yubin Hung	<b>Art Unit</b> 2624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/18/04, 11/27/06</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Specification*

1. Claims 20, 36, 37 and 46 are objected to because of the following informalities:

- Claim 20, line 1: consider replacing “is based” with “is determined basing”
- Claims 36 and 37: consider making both dependent from claim 4 so as to be consistent with their corresponding method claims 14 and 15 (as well as to overcome the USC 112 rejections below)
- Claim 46, lines 12 and 13: suggest changing

“image data signal,

(d) comparing...”

to “image data signal by comparing...” and re-label step (e) to step (d); otherwise original step (d) will also determine a representative image independent of step (c)

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 36, 37, 45 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 36 recites the limitation "the program code for identifying" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim.
5. Claim 37 recites the limitation "the at least one image file" in line 1. There is insufficient antecedent basis for this limitation in the claim.
6. Claim 45 recites the limitation "the image data signal" in lines 3 and 4. There is insufficient antecedent basis for this limitation in the claim. Claim 46 is similarly rejected per dependency. [Note: for examination purpose "an image data" in line 3 will be interpreted as "an image data signal"]

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

In addition, the USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), ANNEX IV, partly reads as follows:

***First paragraph***

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structure and computer programs which impart functionality when employed as a computer component. ...

***Second paragraph***

Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. ...

***Section (a), second paragraph, beginning at line 7***

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowery, 32 F.3d at 1583-84, 32 USPQ2d at 1035. ...

8. Claims 23-42 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter as follows. Claims 23-42 recite *program code*. Since the program is not necessarily a computer program, the inventions of claims 23-42 are not statutory subject matter.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-4, 7, 11, 12, 14-16, 18-20, 22-26, 29, 33, 34, 36-38, 40-42, 44 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (US 2002/0107847).

Regarding claim 1, and similarly claims 7, 11, 12, 14-16, 18-20, 22, 23, 29, 33, 34, 36-38, 40-42, 44 and 45, Johnson discloses the following [abstract; Figs. 7 and 8 (parse received document to, among other things, extract image data signal such as JPEG and GIF), 10 & 12 (representative image associated with article displayed), and paragraphs 33-43; note that paragraph 35 discloses how representative image can be selected by comparing image dimension to a threshold]:

- (a) receiving data associated with an article;
- (b) determining an image data signal for an image associated with the article; and
- (c) determining a representative image for the article based at least in part on the image data signal

11. Regarding claim 2, and similarly claim 24, note that per the analysis above Johnson discloses identifying at least one image file associated with the article.

12. Regarding claim 3, and similarly claim 25, note that Johnson discloses using image height as a score.

13. Regarding claim 4, and similarly claim 26, Johnson further discloses

- determining an image data signal for a plurality of images associated with the article, and  
determining an image data score for each image

[Fig. 7, refs. 1826-1838; note that to carry out step 1828 it is necessary to determine of the height (i.e. score) of the images]

14. Claims 12, 14-16, 34, 36-38 are similarly analyzed and rejected as per claim 1 above especially per Fig. 8 of Johnson.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 5, 6, 8-10, 13, 17, 21, 27, 28, 30-32, 35, 39, 43 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 2002/0107847) as applied to claims 1-4, 7, 11, 12, 14-16, 18-20, 22-26, 29, 33, 34, 36-38, 40-42, 44 and 45 above.

17. Regarding claim 5, and similarly claims 9, 27 and 31, Johnson discloses all limitations of its parent claim and additionally using prominence (as reflected by the size of image, among other things) [paragraph 35]. Therefore it would have been obvious to

select the largest image (i.e., image dimension as the score) as the representative since it would have been the most prominent in terms of size.

18. Regarding claim 6, and similarly claim 28, note that Figs. 10 and 12 of Johnson disclose displaying image with context. Additionally, Official Notice is taken that it is well known to display a representative image (the one with the highest score) along with its score and the reason for modifying Johnson to do so would have been to convey to user the confidence in having the image represent the article.

19. Regarding claim 8, and similarly claims 13, 30 and 35, Official Notice is taken that it is well known to specify a determine image associated with an article and the reason for modifying Johnson to do so would have been to use the image that has being pre-determined as a representative so that the method does not have to rely on an input from the user (to specify how the representative should be selected). Also per the analyses of claim 1 above.

20. Claims 10, and similarly claims 32, is similarly analyzed and rejected as per the analyses of claims 5 and 8 above.

21. Regarding claim 17, and similarly claims 39 and 46, Official Notice is taken that it is well known in the art to use one of the recited images (such as a no image available icon) as the default and the reason for modifying Johnson to do so would have been to



be able to convey to the user the non-existence of any image associated with the article to display.

22. Regarding claim 21, and similarly claim 43, Official Notice is taken that it is well known in the art to include both an article associated with a client and an article associated with the network in the search result and the reason for modifying Johnson to do so would have been to search as wide as possible (i.e., in addition to client only, also search the network) in order to provide both locally available and externally available results.

#### ***Contact Information***

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yubin Hung whose telephone number is (571) 272-7451. The examiner can normally be reached on 7:30 - 4:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew C. Bella can be reached on (571) 272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Yubin Hung  
Patent Examiner  
Art Unit 2624

December 26, 2007

A handwritten signature in black ink, appearing to read 'Yubin Hung', with a long horizontal stroke extending to the right.